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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,191	10/23/2000	Jay S. Walker	96-059X	2479

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 01/07/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/694,191

Applicant(s)

WALKER ET AL.

Examiner

Hyung S. Souh

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15, 18 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 18 and 26-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other: \_\_\_\_\_

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1. In view of pre-amendment filed on April 9, 2001, the Office action mailed on September 12, 2001 has been withdrawn by the Examiner.

***Specification***

2. The disclosure is objected to because of the following informality:

- Page 18, line 4, should "908" be --907--? . .

**Applicant is advised to carefully review the entire specification for further needed corrections.**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 15, 18, and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Vizcaino (US PAT. 5,317,636).

**Re claims 15 and 18:** Vizcaino (FIG. 4) discloses an apparatus comprising: a processing unit (82); an input device (104) in communication with said processing unit (82), said input device (104) operable to input a second account identifier for use in place of a first account identifier thereto, i.e., Vizcaino discloses “that a different verification number is generated and used in the authorization of each different credit card transaction.” (col. 2, line 68-col. 3, line 4) and an “operator 102 is required to provide verification number 44, in order to have the transaction authorized by computer 80.” (col. 13, lines 25-27); a transmitting/receiving device (106) in communication with said processing unit, said transmitting/receiving device (106) operable to (i) transmit the second account identifier for verification thereof and (ii) receive information regarding authorization of the second account identifier; and an output device (104) in communication with said processing unit, said output device operable to output the information regarding authorization of the second account identifier, wherein the second account identifier is a single-use account identifier (verification number) specific to a transaction. Vizcaino further discloses the claimed method (col. 7, line 23-col. 8, line 30).

**Re claim 27:** Vizcaino discloses that the processing unit (82) is associated with a merchant (a station at a retail store).

**Re claim 28:** Vizcaino does not explicitly state that the second account identifier is received from a customer as a means of payment for the transaction. However, col. 8, lines 7-16 thereof, Vizcaino states that a retail transaction could be done by the card holder. Thus, it

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would have been inherent that the second account identifier (i.e., verification number 44) is received from a customer (i.e., a card holder) as a means of payment for the transaction (i.e., processing a retail transaction).

**Re claim 29:** Vizcaino does not explicitly state the claimed step. However, col. 8, lines 3-23 thereof, Vizcaino states that the method can be used at a store and the claimed step would have been inherent, i.e., a clerk will hand over a good ("at least one good") and a transaction receipt ("at least one service associated with the transaction") to a customer upon verification and approval of a transaction.

**Re claim 30:** Vizcaino discloses that a transaction is conducted over the telephone (col. 8, lines 17-23).

**Re claim 31:** Vizcaino discloses that the customer is in a location that is remote from the processing unit (col. 8, lines 17-23).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vizcaino.

**Re claim 26:** Vizcaino does not explicitly disclose that the second account identifier is transmitted to an issuer associated with the first account identifier. However, Vizcaino states that the second account identification number (i.e., the verification number 44) is transmitted to the computer 80 (col. 7, lines 52-59). Further, it would have been within the level of ordinary skill in the art to locate the computer 80 of Vizcaino at any location including at an issuer (i.e., banks, department stores, or phone companies) as desired.

**Re claim 32:** Vizcaino does not explicitly disclose that the information regarding authorization includes an authorization code. However, it is old and well known in the art to use an authorization code (i.e., a transaction approval number) by a credit card issuer (i.e., banks, department stores, or phone companies) upon verification and approval of a transaction requested by a customer.

**Re claim 33:** Vizcaino states "computer 80 is designed to access the accounts of the various customers of the card issuer by reference to the account number." (col. 8, lines 42-44). Vizcaino does not explicitly disclose that "the accounts of the various customers of the card issuer" is located at a central credit card processing system maintained by a credit card issuer. However, it is well-known in the art to store the accounts of the various customers at a central credit card processing system maintained by a credit card issuer to protect the confidential information of the card holders and nothing unobvious is seen to have been involved simply having employed this well known practice for a credit card transaction method of the sort here involved.

**Re claim 34:** Vizcaino discloses the second account identifier (i.e., the verification number 44) comprising a nine-digit identifier (FIG. 2A) rather than a sixteen-digit identifier.

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However, various digits are known in the art used for identifiers (e.g., four-digit for PIN or sixteen-digit for credit/debit card) and the claimed sixteen digit identifier is a matter of obvious design choice which a person of ordinary skill in the art would have found obvious and applicant has provided no evidence that would indicate his particular digit identifier gives rise to any new or unexpected result.

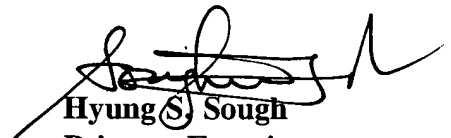
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Each of Pegg (US PAT. 5,163,097) and Walker et al. (US PAT. 6,163,771) discloses a method for verifying a single-use financial account identifier.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0956. The Group Fax numbers are (703) 746-7238 for After-final, (703) 746-7239 for Official, and (703) 746-7240 for Non-Official/Draft.

  
Hyung S. Sough  
Primary Examiner  
Art Unit 2161

shs  
1/2/02